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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,528	07/10/2003	Nigel Howard Julian Brown	AUS920030295US1	3557

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EXAMINER	
KARDOS, NEIL R	
ART UNIT	PAPER NUMBER
3623	

NOTIFICATION DATE	DELIVERY MODE
08/13/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/617,528	BROWN ET AL.	
	Examiner	Art Unit	
	Neil R. Kardos	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 May 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7 and 21-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7 and 21-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This is a **FINAL** Office Action on the merits in response to communications filed on May 13, 2009. Currently, claims 1-7 and 21-34 are pending and have been examined.

Response to Arguments

Applicant's arguments filed on May 13, 2009 have been fully considered but they are not persuasive. Applicant's arguments with respect to the newly-added limitations have been addressed in the body of the rejection, below, which contains an explanation of how the cited art teaches the claimed limitations.

Applicant also argues that Griffor does not teach or suggest encoding proprietary information and trade secrets into the data template. First, Examiner notes that Official Notice was taken that it was well-known in the art at the time the invention was made to encode secret information so as to limit access to confidential data. (See Office Action dated 2/13/2009, pages 8-9). This was done well before the present invention in the form of data encryption. As stated in the previous Office Action, it would have been obvious to one of ordinary skill in the art at the time the invention was made to hide confidential data when performing the consulting methodology of Griffor. One of ordinary skill in the art would have been motivated to do so for the benefit of increased security. Applicant failed to timely traverse this statement of Official Notice; thus, the findings are taken to be admitted prior art. See MPEP § 2144.03(C). See also Office Action dated 2/13/2009, page 9. Furthermore, Griffor at least suggests this limitation. In paragraph 22, Griffor discloses users that have different access levels to the specification tables (i.e. templates). Upper level management is given more access through the management module

than organizational participants are given through the participant module. Thus, the templates of Griffor are encoded with information that is only visible to certain users.

Response to Amendment

Applicant's amendments to the claims are sufficient to overcome the claim objections set forth in the previous Office Action. Accordingly, these objections have been withdrawn.

Applicant's amendment to claim 1 is insufficient to overcome the § 101 rejection set forth in the previous Office Action for the reasons explained below. Furthermore, this amendment has introduced a § 112 rejection, which has been set forth below.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1: Claim 1 is directed toward a method (process), wherein the method (process) comprises a memory. The term "process" in § 101 defines "actions" (i.e. a series of steps or acts to be performed). See MPEP 2106 (IV) (A). A memory is a step or act to be performed; thus, it is unclear how claim 1 is directed toward a method. Clarification is required.

Claims 2-7: The dependent claims are rejected for failing to remedy the deficiencies of the claims from which they depend.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1: Claim 1 is directed toward the statutory category of a process. In order for a claimed process to be patentable subject matter under 35 U.S.C. § 101, it must either: (1) be tied to a particular machine, or (2) transform a particular article to a different state or thing. *See In Re Bilski*, 88 U.S.P.Q.2d 1385 (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method/process is not patentable subject matter under § 101. Thus, to qualify as a statutory process under § 101, the claim should positively recite the machine to which it is tied (e.g. by identifying the apparatus that accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g. by identifying the material that is being changed to a different state). Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. *See Benson*, 409 U.S. at 71-72. Thus, incidental physical limitations such as insignificant extra-solution activity and field of use limitations are not sufficient to convert an otherwise ineligible process into a statutory one.

Here, the claimed process fails to meet the above requirements for patentability under § 101 because it is not tied to a particular machine and does not transform underlying subject matter. Although the claim preamble recites that the method is "in a data processing system," this is merely an incidental physical limitation that is insufficient to tie the claimed process to a particular machine.

Although the claim has been amended to include a memory with software instructions that cause a processor to perform some steps, it is unclear how this memory is part of the claimed method (see § 112 rejection, above). Thus, the § 101 rejection has been maintained until this deficiency is corrected.

Claims 2-7: Dependent claims 2-7 are rejected for failing to remedy the deficiencies of the claims from which they depend.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-7 and 21-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griffor (US 2002/0173999) in view of MacDonald (US 2004/0068429), and further in view of Nandigama (US 2004/0010441).

Claim 1: Griffor discloses a method in a data processing system for providing a consulting assessment environment, the method comprising:

- a memory having a plurality of software instructions stored therein, the plurality of software instructions adapted to cause a processor of a computer to perform the steps of (see ¶¶ 1, 6, 19, and 20, each disclosing storing instructions on a computer):
- determining an intended use for the consulting assessment environment, wherein the intended use is one of defining assessment business logic (see ¶ 15, disclosing recording and structuring information produced by the definition phase of the organizational consulting process; ¶ 18, disclosing decomposing an organization; ¶ 19, disclosing a definitional stage and an organizational framework; ¶ 20, disclosing "business rules logic"; ¶ 21, disclosing specification tables constructed during the definitional phase of the consulting process; ¶ 23 et seq., disclosing specification tables; ¶ 51, disclosing an organizational definition) and conducting a self-assessment (see ¶ 16, disclosing an assessment of an organization to align the organization with its purpose; ¶ 19, disclosing determining success based on actual performance; ¶ 21, disclosing storing performance data; ¶ 22, disclosing allowing participants to give feedback on their individual performance), wherein defining assessment business logic is performed by a consultant (see above-cited sections; figure 2), wherein conducting a self-assessment is performed by the consultant or a client (see above-cited sections; figure 2), and wherein self-assessment data is stored separately from assessment business logic (see figure 3:

item 64, disclosing an organizational performance database, and items 62-63, disclosing action rules and specification tables databases that store business logic; ¶ 6, disclosing separate databases for logic and performance; ¶¶ 20-21);

- responsive to determining that the intended use is defining assessment business logic, defining a data template, an assessment framework template, a suggested actions template, and a report template to create the assessment business logic for multiple types of assessments for assessing businesses (see sections cited below, particularly ¶¶ 4, 6, 19-21, and 23-52, disclosing creating and linking specification tables that serve as data templates for assessments and action rules), further comprising:
    - encoding the data template, the assessment framework template, the suggested actions template, and the report template with formulas and logic rule definitions to define how self-assessment data is used to generate assessment results and recommendations (see ¶¶ 4, 6, 19-21, 23-52, and 65-66; the reference discloses creating specification tables [¶ 23 et seq.] with weights [¶¶ 25-26], formulas [¶¶ 43, 46, 48, and 49], and action rules [¶ 50] that define how the assessment data is used to generate results [¶ 23, recording the results; ¶¶ 41-43, value assessment; ¶ 50] and recommendations [¶ 65, disclosing recommendations for improvement]);
    - translating a plurality of hypotheses into interview questions for assessing a current state of a business (see ¶¶ 79-81, disclosing an interview question addressing what changes could be made in order to improve an

element of the organizational goals; see also ¶¶ 54-64 and 72-76, disclosing interview questions based on the most commonly-asked questions);

- responsive to determining that the intended use is conducting a self-assessment, receiving self-assessment data about the business through a questionnaire (see ¶¶ 17-18, disclosing determining the organization's goals, etc.; ¶ 23 et seq., disclosing gathering information generated during the definition phase; ¶¶ 28-31; ¶ 77; figure 2: items 1-4);
- responsive to receiving the self-assessment data about the business, computing at least one assessment score based on formulas and rules encoded in the assessment framework template (see ¶ 19, disclosing quantitatively measuring the importance of deliverables; figure 5, depicting relative value and total value; various figures disclosing point values; ¶¶ 41-50; ¶ 79; ¶ 82)
- responsive to computing the at least one assessment score, determining an appropriate action based on the at least one assessment score and the suggested actions template encoded with business-related domain knowledge that defines actions to achieve desired states of business (see ¶¶ 19 and 21, disclosing actions rules used to maintain alignment between performance and goals; ¶ 22, disclosing action rule module that provides actions to be taken to help achieve organizational goals; ¶ 50, disclosing constructing action rules based on weights; ¶¶ 65-66; ¶ 82)
- reporting results of the self-assessment data based on the at least one assessment score and the appropriate action in accordance with the report template, wherein

the data template, the assessment framework template, and the suggested actions template encode business-related domain knowledge including at least one of best practices, business consultant expertise, and business goals (see ¶¶ 54-58, disclosing a management module which provides reports to management; ¶¶ 59-64, disclosing a participant module which provides reports to workers; ¶¶ 72-80).

It is not explicitly clear whether Griffor discloses the claimed "templates" for storing data (although Griffor does disclose specification tables). MacDonald discloses a similar consulting system for strategic performance management that uses templates in the form of Microsoft Excel spreadsheets (see ¶ 36). It would have been obvious to one of ordinary skill in the art at the time the invention was made to record the information of Griffor in the templates of MacDonald. One of ordinary skill in the art would have been motivated to do so for the benefit of efficiencies gained by storing information in reusable templates.

Further, Griffor does not explicitly disclose wherein the questionnaire is defined using the data template encoded with the interview questions and business-related domain knowledge of business practices. Nandigama discloses this limitation (see figure 5). Furthermore, Examiner takes Official Notice that it was well-known in the art at the time the invention was made to store questions in a template. It would have been obvious to one of ordinary skill in the art at the time the invention was made to define the questions asked by Griffor according to a template (such as that in Nandigama or those known in the art). One of ordinary skill in the art would have been motivated to do so for the benefit of efficiencies gained by storing information in reusable templates.

Griffor does not explicitly disclose encoding proprietary information and trade secrets into the data template, the assessment framework template, the suggested actions template, and the report template. However, these limitations are not sufficient to distinguish the claimed invention over the prior art because Griffor manipulates data in the same way as the claimed invention. In other words, the recited method steps would be performed in the same manner regardless of whether or not proprietary information and trade secrets are encoded into the templates. Thus, the prior art and the claimed invention have identical structure and the claimed descriptive material is insufficient to distinguish the claimed invention over the prior art. *see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.* Griffor does not explicitly disclose wherein the proprietary information and the trade secrets of the consulting assessment environment are accessible to the consultant and are made inaccessible to clients using a hiding feature. Examiner takes Official Notice that it was well-known in the art at the time the invention was made to limit access to confidential data. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to hide confidential data from clients when performing the method of Griffor. One of ordinary skill in the art would have been motivated to do so for the benefit of increased security. Furthermore, Examiner notes that Applicant has failed to traverse Examiner's Official Notice, which was originally set forth in the previous Office action. Therefore, the above findings of Official Notice are taken to be admitted prior art. See MPEP § 2144.03 (C).

Examiner also notes that MacDonald and Nandigama also disclose many of the above limitations that Griffor has been shown to disclose.

Claim 2: Griffor discloses:

- determining the current state of the business based on the self-assessment data (see ¶ 4, disclosing actual performance; ¶¶ 15-16; ¶ 77);
- identifying a desired state for the business using the assessment framework template and the suggested actions template to analyze the self-assessment data and to determine new business insights and recommendations for the business (see ¶ 4, disclosing organizational goals; ¶¶ 15-16; ¶ 65, disclosing recommendations for improvement; ¶ 77); and
- performing a gap analysis between the current state of the business and the desired state of the business to determine appropriate action to achieve the desired state for the business using the suggested actions template (see ¶ 4, disclosing aligning performance and goals; ¶¶ 15-16; ¶ 77, disclosing determining the gaps between performance and vision-required tasks).

Claim 3: The cited references do not explicitly disclose identifying benefits and risks for the current state of the business and for moving to a desired state of the business based on the at least one assessment score and the appropriate action. Examiner takes Official Notice that it was well-known in the art at the time the invention was made to perform cost/benefit or risk/benefit analyses. It would have been obvious to one of ordinary skill in the art at the time the invention was made to perform a risk/benefit analysis on the current business state and proposed action of

Griffor. One of ordinary skill in the art would have been motivated to do so for the benefit of making a more informed decision.

Claim 4: Griffor discloses consolidating portions of the results together for further analysis, wherein the appropriate action is determined for a particular division or unit of the business. (see various figures, which include consolidated results and scores; ¶ 4, disclosing different organizational levels).

Claim 5: Griffor discloses providing an interface for the client to conduct the self-assessment to gather the self-assessment data about the business, wherein the self-assessment data is used to determine the current state of the business, and wherein automated data synthesis is performed to relate the current state of the business to a desired state of the business in real time. (see figure 3: item 52, disclosing a GUI).

Claim 6: Griffor discloses wherein the data template includes at least one of the interview questions, weighing factors (see ¶¶ 21, 44-49), desired states (see ¶¶ 16-19, 21), benefit descriptions, risk descriptions, suggested actions (see ¶¶ 21-22), cost areas, and terminology. Furthermore, Examiner notes that the claimed contents of the data template amount to non-functional descriptive material that do not functionally alter the claimed method. The recited method steps would be performed in the same manner regardless of what data is contained in the data template. Thus, the prior art and the claimed invention have identical structure and the claimed descriptive material is insufficient to distinguish the claimed invention over the prior art.

see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.

Claim 7: Griffor discloses wherein the assessment framework template includes at least one of scoring information (see ¶¶ 26, 41-49), calculations (see id.), suggested actions logic (see ¶¶ 21-22), benefit and risk logic, user feedback, and user input). Furthermore, Examiner notes that the claimed contents of the assessment framework template amount to non-functional descriptive material that do not functionally alter the claimed method. The recited method steps would be performed in the same manner regardless of what data is contained in the assessment framework template. Thus, the prior art and the claimed invention have identical structure and the claimed descriptive material is insufficient to distinguish the claimed invention over the prior art. *see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.*

Claims 21-34: Claims 21-34 are substantially similar to claims 1-7 and are rejected under similar rationale.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. Kardos whose telephone number is (571) 270-3443. The examiner can normally be reached on Monday through Friday from 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Neil R. Kardos
Examiner
Art Unit 3623

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